

REMARKS

I. Background

The office action mailed March 25, 2011 has been received and reviewed. It is noted that the office action was “on final.”

In the office action a §112 rejection was raised. Also raised was a double patenting rejection. Finally, claim 23 was rejected on art.

II. Request for Extension of Time

It is noted that a three-month extension of time is needed for timeliness of the present response. A request for such an extension is made.

III. Previous Request for Interview; Interview Summary Record

Applicants’ Representatives called the Examiner June 16, 2011 to request an oral interview in Washington to discuss the §112 rejection and the double patenting rejection. The Examiner said he was not available for the interview. The Examiner invited Applicants’ Representatives to make their submissions in writing, and did invite them, as to the double patenting rejection, to not if this file would be the first to issue.

During the telephone conference of June 16, 2011, no argument and discussion with respect to either the §112 rejection or the double patenting rejection was actually presented. The interview was merely to discuss the availability of the Examiner for the in person interview. To the extent that the interview summary record of June 17, 2011 suggests to the contrary, Applicants disagree.

Herein, amendments are requested to address the Examiner’s §112 rejection in the office action of March 25, 2011. Also, presented is updated information and discussion regarding the reasons why the double patenting rejection should be withdrawn.

IV. Cancellation of Claim 23

It is noted that the Examiner rejected claim 23 under §103. While Applicants do not necessarily agree with the Examiner's rejection, claim 23 has been cancelled to facilitate prosecution of the claims indicated as allowable over the art.

V. The Amendments and the Examiner's §112 Rejection

The Examiner raised a §112 second paragraph rejection with respect to the phrase "to the housing within" as used in claim 1(b). While Applicants do not agree with the asserted lack of clarity, an amendment has been made to avoid the issue raised by the Examiner. No new matter is involved.

It can be seen that the suction filter assembly is indeed secured to the housing, by referring to the embodiment of Fig. 3, in which a portion of the housing is indicated at 66 and the suction filter assembly is indicated at 10. This is also shown in Fig. 3A, where the housing sidewall is indicated at 7 and the suction filter assembly is indicated at 10. Again, no new matter is involved in the amendment.

The Examiner raised a rejection concerning antecedent basis with respect to 1(b)(i) and the extension of suction filter media defining a central volume. Again, Applicants disagree with the Examiner's position, since no definite article was used with respect to the term "central volume." However, to avoid confusion with any other volumes, the claim has been amended to indicate that the suction filter media surrounds and defines a suction filter media central volume. This can be understood from the specification by reviewing the media in Fig. 3 at 170, surrounding the central volume indicated at 173.

The Examiner also asserted, generally, that claim 1 was confusing for lack of structural links between the housing liquid filter assembly, the suction filter assembly, central volume and suction filter media. As now amended, it is believed any such issue is avoided. The suction filter assembly is defined as secured to the housing of the liquid filter assembly in liquid flow communication with the restrictor liquid/inlet/outlet. It is also defined as including the suction

filter media surrounding and defining a suction filter media central volume. It is believed, therefore, that any issue of lack of clarity is addressed by the current amendments.

VI. The Double Patenting Rejection

The Examiner raised a double patenting rejection to claims 1-18 and 23 (now cancelled) for obviousness type double patenting rejection as unpatentable over claims 1-19 of co-pending application number 12/310,468 (M&G 758.2050USWO).

The claims currently pending in serial number 12/310,468 are attached hereto as Exhibit A. It is believed that the present claims avoid any such double patenting rejection.

The present claims, see claim 1, require a combination that includes: an extension of suction filter media surrounding and defining a suction filter media central volume; and, a first, non-helical spring directionally biased valve arrangement in a suction filter assembly that is oriented to permit liquid flow from a tank reservoir through the suction filter media and into a housing interior, and to resist liquid flow from the housing interior through the suction filter media and then into the tank reservoir. This overall construction is indicated as an example in Fig. 3 with the combination of the media 170, the central volume 173 and the valve member 54, in the example depicted comprising the described cut valves 176.

Turning now to the claims of USSN 12/310,468, Exhibit A, this combination of features is not claimed anywhere in those claims. Claim 1, for example, describes a cartridge that has a bypass filter cartridge but no suction valve is described and indeed none is characterized in any of the claims of USSN 12/310,468.

Since the present claims pending in the current application all require, among other things, a suction filter assembly comprising a combination of suction filter media as defined and a non-helical spring directionally biased valve arrangement as defined, and since no such arrangement is found in any of the claims of USSN 12/310,468, a double patenting rejection is necessarily avoided.

Therefore, it is believed that the double patenting rejection is inappropriate and should be withdrawn.

It is noted that certain of the claims of USSN 12/310,468 do reference a bypass valve. However, that bypass valve, see for example, claim 14, is a valve member biased by the spring member to a closed position and thus is a different type of structure and is differently positioned.

The claims of USSN 12/310,488 do reference a suction filter assembly, see for example claim 14(c). However, the suction filter assembly is not defined in the claims of 12/310,468, in detail. Thus, again no double patenting is involved.

In any event, the current status of USSN 12/310,468 is that it is a later filed application pending with no office action having been issued yet. Therefore, the present application is both the earlier filed application and the application which is expected to issue first. Thus, for this reason also, a terminal disclaimer is not required.

VII. Summary

In sum, claim 23 has been cancelled, claim 1 has been amended to address the Examiner's §112 concerns. An assertion is made that the double patenting rejection is avoided, but in any event, the present application is the earlier priority and will likely be the earlier issued patent of the two, and thus, no terminal disclaimer is submitted.

Claims 1-18 are pending and believed allowable.

The Examiner is invited to contact Applicants' Representative at the below listed telephone number if it is believed that prosecution may be assisted thereby.

Respectfully submitted,

MERCHANT & GOULD P.C.
P.O. Box 2903
Minneapolis, Minnesota 55402-0903
(612) 336-4707

Dated: September 20, 2011

Signed: /Randall A. Hillson/
Randall A. Hillson
Reg. No. 31,838
RAH/jer

23552

PATENT TRADEMARK OFFICE